

REMARKS

The present application has been reviewed in light of the Office Action mailed August 24, 2006. It is respectfully submitted that the claims pending in the application are patentable over the prior art. Reconsideration of the present application is respectfully requested in view of the following arguments and remarks.

In the Office Action mailed on August 24, 2006, claims 1, 6 and 7 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,204,541 to Kapitanov ("Kapitanov '541"). The Office Action asserted that Kapitanov '541 discloses an applicator for attaching fasteners to body tissue comprising, *inter alia*, a distal portion having an elongate outer tube, a connecting end and a terminal end, a proximal portion having a handle and an actuator, the proximal portion being attached to the connecting end of the distal portion, and a rotator cooperating with the actuator and including a longitudinal groove extending along at least a portion of the length of the rotator, the groove configured to receive a portion of a fastener. Moreover, the Office Action stated that Kapitanov '541 discloses a nose piece attached to the terminal end, the nose piece having structure projecting perpendicularly toward a longitudinal axis of the outer tube and adapted to engage the plurality of fasteners. In addition, the Office Action noted that Kapitanov '541 discloses the distal portion and the proximal portion being releasably secured together.

Claim 1 recites an applicator for attaching fasteners to body tissue including, *inter alia*, "a rotator cooperating with the actuator and including a longitudinal groove extending along at least a portion of the length of the rotator." Support for this recitation is found on page 19, lines 7-9 of the specification and in Figure 6A (reproduced hereinbelow).

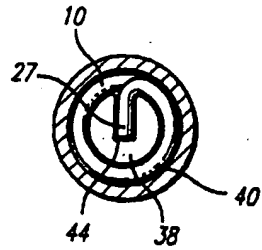


FIG. 6A

In contrast, Kapitanov '541 discloses "a cylindrical rod 10 running inside the hollow cylinder 8 and having a screw thread 11 adapted to engage a stud pin 12." (See column 3, lines 35-38 and Figures 1 and 2 as reproduced hereinbelow). The helical screw thread 11 disclosed in Kapitanov '541 is not a longitudinal groove. Thus, Kapitanov '541 does not disclose or suggest a surgical instrument including a rotator having a "longitudinal groove extending along at least a portion of the length of the rotator" as recited in claim 1.

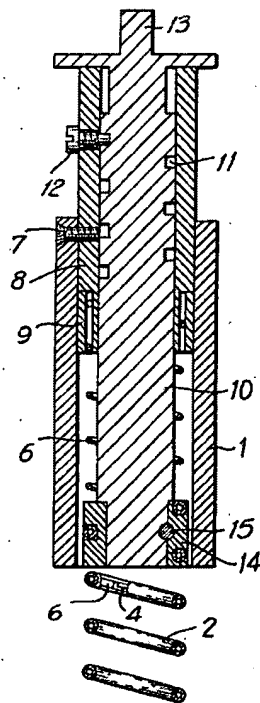


FIG. 1

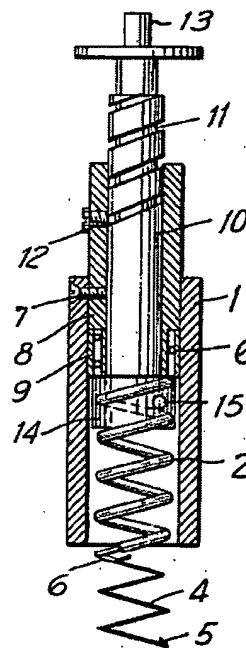


FIG. 2

In light of the foregoing, applicants respectfully submit that Kapitanov '541 fails to anticipate or suggest claim 1 and that the rejection of the Office Action has been overcome. Since claims 6 and 7 depend from claim 1, and contain all of the features of claim 1, for at least the reasons presented above, applicants respectfully submit that claims 6 and 7 are also allowable over Kapitanov '541.

Claims 2 and 3 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kapitanov '541 in view of U.S. Patent No. 4,596,350 to Smith et al. ("Smith '350"). According to the Office Action, Kapitanov '541 discloses the devices recited in claims 2 and 3 except for a lock/clip indicator and a load spring. The Office Action stated that the Smith '350 discloses a lock/clip indicator for engaging a plurality of fasteners from the applicator and a load spring for applying longitudinal forces against the lock/clip indicator.

As previously discussed, the Kapitanov '541 does not disclose or suggest a rotator including a "longitudinal groove extending along at least a portion of the length of the rotator." The Smith '350 fails to disclose or suggest any additional features that, in combination with the Kapitanov '541, would suggest the applicator of claims 2 and 3. Therefore, adding the lock/clip indicator and load spring from the Smith '350 to the Kapitanov '541 fails to disclose or suggest an applicator including a rotator having a longitudinal groove as recited in claim 1. Since claims 2 and 3 depend from claim 1, it is respectfully submitted that these claims are in condition for allowance and the rejection of the Office Action has been overcome.

Claims 4 and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kapitanov '541 in view of U.S. Patent No. 5,433,721 to Hooven et al. ("Hooven '541"). The Office Action asserted that Kapitanov '541 discloses the devices recited in claims 4 and 5 except for a thread form contained in an interior of the terminal end. The Office Action stated

that the Hooven '541 discloses a thread form contained in an interior of the terminal end adapted to engage the plurality of fasteners and being an interlock spring fixedly retained in the interior of the terminal end.

As previously discussed, the Kapitanov '541 does not disclose or suggest a rotator including a "longitudinal groove extending along at least a portion of the length of the rotator." The Hooven '541 fails to disclose or suggest any additional features that, in combination with the Kapitanov '541, would suggest the applicator of claims 4 and 5. Accordingly, adding the helical thread form from the Hooven '541 to the Kapitanov '541 fails to disclose or suggest an applicator including a rotator having a longitudinal groove as recited in claim 1. Since claims 4 and 5 depend from claim 1, it is respectfully submitted that these claims are in condition for allowance and the rejection of the Office Action has been overcome.

Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kapitanov '541 in view of U.S. Patent No. 5,100,420 to Green et al. ("Green '420"). According to the Office Action, Kapitanov '541 discloses the device recited in claim 8 except for a distal portion being disposable and the proximal portion being reusable. The Office Action noted that the Green '420 discloses a distal portion being disposable and the proximal portion being reusable. As discussed above, the Kapitanov '541 does not disclose or suggest a rotator including a "longitudinal groove extending along at least a portion of the length of the rotator." The Green '420 fails to disclose or suggest any additional features that, in combination with the Kapitanov '541, would suggest the applicator of claim 8. Therefore, adding the distal and proximal portions from the Green '420 to the Kapitanov '541 fails to disclose or suggest an applicator including a rotator having a longitudinal groove as recited in claim 1. Since claim 8 depends from claim 1, it is respectfully submitted that this claim is in condition for allowance and the rejection of the

Office Action has been overcome.

Claims 9 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kapitanov '541 in view of U.S. Patent No. 5,607,436 to Pratt et al. ("Pratt '436"). The Office Action asserted that Kapitanov '541 discloses the devices recited in claims 9 and 14 except for a lever having a first end, a midsection, a second end, a lead screw, and a nut driver. The Office Action stated that the Pratt '436 discloses a lever having a first end, a midsection, a second end, a lead screw, and a nut driver.

As discussed hereinabove, the Kapitanov '541 does not disclose or suggest a rotator including a "longitudinal groove extending along at least a portion of the length of the rotator." The Pratt '436 fails to disclose or suggest any additional features that, in combination with the Kapitanov '541, would suggest the applicator of claims 9 and 14. Thus, adding the lever from the Pratt '436 to the Kapitanov '541 fails to disclose or suggest an applicator including a rotator having a longitudinal groove as recited in claim 1. Since claims 9 and 14 depend from claim 1, it is respectfully submitted that these claims are in condition for allowance and the rejection of the Office Action has been overcome.

Claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kapitanov '541 in view of Pratt '436. The Office Action noted that Kapitanov '541 discloses the device recited in claim 11 except for a lever having a midsection extension. The Office Action further stated that the Pratt '436 discloses a lever having a midsection extension.

As discussed above, the Kapitanov '541 does not disclose or suggest a rotator including a "longitudinal groove extending along at least a portion of the length of the rotator." The Pratt '436 fails to disclose or suggest any additional features that, in combination with the Kapitanov '541, would suggest the applicator of claim 11. Consequently, adding the lever from the Pratt

'436 to the Kapitanov '541 fails to disclose or suggest an applicator including a rotator having a longitudinal groove as recited in claim 1. Since claim 11 depends from claim 1, it is respectfully submitted that this claim is in condition for allowance and the rejection of the Office Action has been overcome.

Claims 12, 13, 16 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kapitanov '541 in view of Pratt '436. According to the Office Action, Kapitanov '541 discloses the devices recited in claims 12, 13, 16, and 18 except for gear teeth, a spring loaded pawl, and a ratchet mechanism. The Office Action asserted that the Pratt '436 discloses gear teeth formed within the interior of a handle, a spring loaded pawl pivotally attached to the midsection extension and adapted to engage the gear teeth, the releasable engagement means being a ratchet mechanism.

As discussed hereinabove, the Kapitanov '541 does not disclose or suggest a rotator including a "longitudinal groove extending along at least a portion of the length of the rotator." The Pratt '436 fails to disclose or suggest any additional features that, in combination with the Kapitanov '541, would suggest the applicator of claims 12, 13, 16, and 18. Therefore, adding gear teeth, a spring loaded pawl, and a ratchet mechanism from the Pratt '436 to the Kapitanov '541 fails to disclose or suggest an applicator including a rotator having a longitudinal groove as recited in claim 1. Since claims 12, 13, 16, and 18 depend from claim 1, it is respectfully submitted that these claims are in condition for allowance and the rejection of the Office Action has been overcome.

Claim 17 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kapitanov '541 in view of U.S. Patent No. 5,487,500 to Knodel et al. ("Knodel '500"). The Office Action stated that Kapitanov '541 discloses the device recited in claim 17 except for a mid-section

extension with formed plurality of teeth. The Office Action asserted that the Knodel '500 discloses a mid-section extension with formed plurality of teeth.

As previously discussed, the Kapitanov '541 does not disclose or suggest a rotator including a "longitudinal groove extending along at least a portion of the length of the rotator." The Knodel '500 fails to disclose or suggest any additional features that, in combination with the Kapitanov '541, would suggest the applicator of claim 17. Accordingly, adding the mid-section extension from the Knodel '500 to the Kapitanov '541 fails to disclose or suggest an applicator including a rotator having a longitudinal groove as recited in claim 1. Since claim 17 depends from claim 1, it is respectfully submitted that this claim is in condition for allowance and the rejection of the Office Action has been overcome.

Claims 10 and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kapitanov '541. The Office Action asserted that Kapitanov '541 discloses the devices recited in claims 10 and 15 except for the lead screw being a high helix lead screw and that it would have been obvious to provide a high helix lead screw.

As discussed above, the Kapitanov '541 does not disclose or suggest a rotator including a "longitudinal groove extending along at least a portion of the length of the rotator." Adding a high helix lead screw as asserted in the Office Action still fails to suggest the device recited in claim 1. Since claims 10 and 15 depend from claim 1, it is respectfully submitted that these claims are in condition for allowance and the rejection of the Office action has been overcome.

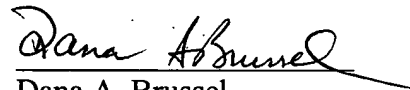
Appl. No. 10/755,427

Communication dated November 21, 2006

Reply to Office Action Mailed August 24, 2006

In view of the foregoing, reconsideration of the application and allowance of claims 1-18 is earnestly solicited. Should the Examiner desire a telephonic interview to resolve any outstanding matters, the Examiner is sincerely invited to contact the undersigned at (631) 501-5713.

Respectfully submitted,



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